

## REMARKS

Claims 1-6, 8, 9, 18-21, 23-25, 33-41, 48, 50 and 51 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Rule 131 Declaration:**

In the present Office Action the Examiner states that the evidence submitted in Applicant's Rule 131 Declaration filed November 27, 2006 is insufficient to establish diligence from a date prior to the Hendriks (US 2002/0087621) reference to either a constructive reduction to practice or an actual reduction to practice. Applicant strongly traverses the Examiner's assertion for at least the following reasons.

**The Examiner has provided no basis in fact for his assertion.** The Examiner merely concludes the Applicant's evidence is insufficient to establish diligence without providing any factual analysis whatsoever. The Examiner merely cites two cases and a section from the MPEP. However, the Examiner does not show how any of his citations support his conclusion that Applicant's evidence is insufficient to establish diligence. Applicant's assert that the submitted evidence is clearly sufficient to establish diligence under the cases and MPEP section cited by the Examiner. For example, the Examiner cites *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). *Haskell v. Coleburne* is a case concerning whether a draft of a patent application prepared for the incorrect inventors can serve as evidence of conception. The question of diligence is hardly discussed in the case. The six day time period from completion of the draft to filing that was considered to be diligent was in regard to filing the completed application, **not preparing the application**. Thus, *Haskell* does not support the Examiner's statement that "taking one month for preparing and filing a patent application, based on the evidences provided by the Applicant, is not an acceptable diligence." There is nothing in the *Haskell* case that would indicate that the facts shown by Applicant are insufficient to establish diligence.

The Examiner also cites *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986). However, *Bey v. Kollonitsch* involved an even longer time period for preparation and filing than exists for Applicant's Rule 131 Declaration. In *Bey v. Kollonitsch* the court found that preparation and filing of a patent application over a **41 day period** was diligent even though the attorney was also working on other applications. The 41 day period that was held to be diligent in *Bey v. Kollonitsch* is much longer than the 27 day period for Applicant's Rule 131 Declaration. Thus, the Examiner's reliance on *Bey v. Kollonitsch* is clearly misplaced. ***Bey v. Kollonitsch* actually supports a finding of diligence for Applicant's Rule 131 Declaration.**

The Examiner also refers to MPEP 2138.06. However, there is absolutely nothing in MPEP 2138.06 that supports that Examiner's assertion that Applicant's evidence is insufficient to establish diligence. The section of MPEP 2138.06 discussing diligence required in preparing and filing a patent application merely discussed the two cases cited above. As discussed above, neither of these cases supports the Examiner's assertion that Applicant's evidence is insufficient to establish diligence. In fact, the holding in *Bey v. Kollonitsch* that a 41 day time period for preparation and filing is **directly counter** to the Examiner's statement that "taking one month for preparing and filing a patent application, based on the evidences provided by the Applicant, is not an acceptable diligence."

Applicant also notes numerous other cases in which time periods much longer than the 27 days here have been held to be diligent. See, e.g., *Monsanto Co. v. Mycogen Plant Science, Inc.*, 261 F.3d 1356, 1369, 59 USPQ2d 1930 (Fed. Cir. 2001) (work over 11 months held to be diligent in spite of gaps); *Gould v. General Photonics Corp.*, 534 F. Supp 399, 404, 215 USPQ 117, 120 (N.D. Calif. 1982) (attorney working to prepare and file patent application over four month period held to be diligent); *Jones v. Evans*, 46 F.2d 197, 202, 8 USPQ 240, 245 (1931) (finding diligence despite a near three month interval in which it did not affirmatively appear that any steps were being taken but during which some activity was ongoing). "Proof of reasonable diligence, however, does not require a party to work constantly on the invention or to drop all other work."

*Mycogen Plant Science, Inc. v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001).

Applicant's evidence is clearly sufficient to establish diligence. **The Examiner seems to be mistakenly applying the evidentiary standard for diligence that is required in interference proceedings.** Applicant notes that the MPEP section and cases cited by the Examiner all pertain to interferences. However, although the concept of diligence under 131 is similar to the diligence requirement for interference proceedings, **the evidentiary standard for Rule 131 Declarations is not the same as for interference proceedings.** *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979). In fact, as noted in MPEP 715.07.III, **"in interference practice**, conception, reasonable diligence, and reduction to practice require corroboration, **whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects.**" (emphasis added). *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953). Applicant's Rule 131 Declaration provides much more than a mere allegation of diligence. For example, Applicant's Rule 131 Declaration includes a specific statement from the inventor that he diligently worked with his attorney during the relevant time period to prepare and file the application. Applicant's Rule 131 Declaration also includes a specific statement from the inventor's attorney stating that he was diligently working on preparation and filing of the patent application during the relevant period along with other cases contemporaneously on his docket. Evidence has also been submitted showing that documents for the preparation and filing of the patent application were being modified throughout the relevant time period. This evidence is more than sufficient to establish diligence. The Examiner cannot arbitrarily refuse a Rule 131 declaration. In fact, "The PTO is required to accept Rule 131 Affidavits at face value, and without investigation." *Herman v. William Brooks Shoe Co.*, 39 USPQ2d 1773, 1777 (S.D. N.Y. 1996).

For at least the above reasons Applicant asserts that the Rule 131 Declaration filed November 27, 2006 is more than sufficient to establish diligence from a date prior to the Hendriks (US 2002/0087621) reference to a constructive reduction to practice.

Applicant also notes that in telephone discussions between Applicant's undersigned attorney and Examiner Dalencourt and Special Programs Examiner Brian Johnson prior to the filing of the current Rule 131 Declaration, both Examiner Dalencourt and Examiner Johnson stated that Applicant's evidence was sufficient to overcome the Hendriks reference. Applicant also notes that in the Office Action of July 27, 2006, Examiner Dalencourt stated that Applicant's evidence was sufficient to establish diligence. Applicant strongly objects to the unsupported, arbitrary and capricious nature by which the Examiner has reversed his position on this issue in the present Office Action.

**Section 102(e) Rejection:**

The Examiner rejected claims 1-6, 18-21 and 48 under 35 U.S.C. § 102(e) as being anticipated by Hendriks (U.S. Publication 2002/0087621). Applicant respectfully traverses this rejection for at least the reasons below.

As noted above, the Rule 131 Declaration is clearly sufficient to establish Applicant's date of invention as prior to December 29, 2000. Therefore, Hendriks (U.S. Patent Application 2002/0087621) is removed as a prior art reference since its prior art date is December 29, 2000. Accordingly, Applicants respectfully request removal of the §102(e) rejection of claims 1-6, 18-21 and 48.

**Section 103(a) Rejections:**

The Examiner rejected claims 8, 9, 23-25, 50 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Hendriks in view of De Greef et al. (U.S. Patent 6,549,217) (hereinafter "De Greef"), and claims 33-41 as being unpatentable over Hendriks in view of Mendelevitch et al. (EP 1030247) (hereinafter "Mendelevitch").

Applicant respectfully traverses this rejection for at least the reasons below.

As noted above, Hendriks is not prior art in light of Applicant's declaration under 37 C.F.R. § 1.131. Therefore, Applicants respectfully request removal of the §103(a) rejections of claims 8, 9, 23-25, 33-41, 50 and 51.

## CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-78600/RCK.

Respectfully submitted,

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